

REMARKS

I. Introduction

Claims 1-20 are pending in the present application. In view of the following remarks, it is respectfully submitted that claims 1-20 are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1-6, 10-11 and 17-18 under 35 U.S.C. § 102(b)

Claims 1-6, 10-11 and 17-18 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,963,995 ("Lang").

As regards the anticipation rejection of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flow from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic.

Claim 1 recites, in relevant parts, "a network port for communicatively connecting the DVRC with at least one other apparatus on a network"; "the DVRC is further adapted to receive through the network port a second selection of digitized video signals, wherein the second selection includes one or more digitized video signals being transmitted by a second other apparatus on the network"; and "the DVRC is adapted to facilitate designation of the digitized video signals of the second selection."

Regarding the Examiner's assertions with respect to the teachings of Lang as applied against the rejected claim 1, Applicants note that the actual teachings of Lang do not support the Examiner's contentions. In the "Response to Arguments" section of the Office Action, the Examiner contends that Lang teaches a network port for the DVRC since "Lang teaches the apparatus and another apparatus are in a network since the apparatus and another apparatus can communicate, receive and transmit the digitized video signals . . . [and] the recited network port is a port for receiving or transmitting the digitized video signals (See Lang column 7, lines 30-65, and column 14, lines 54-68)." The Examiner's contentions are essentially that a network port is inherently disclosed in Lang. However, to the extent that the Examiner is relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). As explained in further detail below, the allegedly inherent characteristics simply do not necessarily flow from the teachings of the applied art.

Initially, Applicants note that the actual disclosure of Lang clearly does not explicitly teach a "network port." Furthermore, to the extent the Examiner cites element 22 of Lang as being equivalent to the claimed "network port," Lang clearly indicates that audio/video transmitter/receiver 22 is connected to a conventional telephone connection, which is in turn connected to a video recorder, (see, e.g., col. 9, l. 59-62), which necessarily means the audio/video transmitter/receiver 22 is a modem that implements a point-to-point connection to a second video recorder via a telephone line. However, the disclosure clearly does not imply that the audio/video transmitter/receiver 22 is a network port for a connection to a network.

Independent of the above, Applicants note that the Examiner's asserted interpretation of the disclosure of Lang contradicts the anticipation conclusion. In support of the rejection, the Examiner contends in paragraph 2 of the Office Action that Lang discloses "a network port (22) for communicatively connecting the DVRC with at least one other apparatus on a network," and "the DVRC is further adapted to receive through the network port (36, 37, 35) a second selection of digitized video signals." While the Examiner cites two separate

components as allegedly being equivalent to the claimed “network port” features, claim 1 clearly recites that the same network port is involved in “communicatively connecting the DVRC with at least one other apparatus” and receiving “a second selection of digitized video signals.” In any case, it should be noted that connections 35, 36, 37 clearly do not represent “network ports”; instead, these components are point-to-point connections. In particular, according to column 7, lines 29 to 31 of Lang, selector switch 35 is provided for the selection of a video connection or a TV receiver; according to column 7, lines 41 and 42 of Lang, switch 36 is provided for the selection of a video connection; and according to column 8, lines 3 to 6 of Lang, switch 37 is provided for the selection of an optical connection.

Independent of the above, Lang clearly does not teach or suggest that the DVRC stipulates the video signals of the second selection, i.e., “facilitate designation of the digitized video signals of the second selection,” as recited in claim 1. Although the Examiner cites col. 7, l. 30-45; col. 8, l. 30-60; and col. 9, l. 55 – col. 10, l. 5, as teaching the above-recited feature of claim 1, the cited sections of Lang do not actually teach or suggest the claimed feature. Nothing in Lang even remotely suggests that video recorder 10 controls a signal source connected via switches 35, 36, 37, let alone that any such control relates to the determination of the second selection. Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In this regard, Lang clearly does not enable a person having ordinary skill in the art to practice the claimed invention, including “facilitate designation of the digitized video signals of the second selection.”

For at least the foregoing reasons, claim 1 and its dependent claims 2-6 and 10-11 are not anticipated by Lang. Applicants note that claim 17 recites features substantially similar to the above-discussed features of claim 1, i.e., “a DVRC network port” and “the first DVRC is adapted to receive through the DVRC network port a selection of a digitized video signals,” so claim 17 and its dependent claim 18 are similarly not anticipated by Lang, at least for the reasons stated in connection with claim 1.

In view of all of the foregoing, withdrawal of the anticipation rejection is respectfully requested.

III. Rejection of Claim 7 under 35 U.S.C. § 103(a)

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 5,930,473 (“Teng”).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

First of all, claim 7 depends on claim 1. Furthermore, the teachings of Teng simply do not remedy the deficiencies of Lang as applied against parent claim 1, e.g., Teng similarly fails to teach or suggest that the DVRC stipulates the video signals of the second selection, i.e., “facilitate designation of the digitized video signals of the second selection,” as recited in amended claim 1. For at least these reasons, dependent claim 7 is not rendered obvious by the combination of Lang and Teng.

IV. Rejection of Claims 8 and 9 under 35 U.S.C. § 103(a)

Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 5,666,363 (“Osakabe”).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and

not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

First of all, claims 8 and 9 ultimately depend on claim 1. Furthermore, the teachings of Osakabe simply do not remedy the deficiencies of Lang as applied against parent claim 1, e.g., Osakabe similarly fails to teach or suggest that the DVRC stipulates the video signals of the second selection, i.e., “facilitate designation of the digitized video signals of the second selection,” as recited in claim 1. In addition, while the Examiner contends that col. 7, l. 15 to col. 8, l. 15 of Osakabe teaches the feature that “the DVRC is further adapted to transmit a first control signal to the second other apparatus, wherein the first control signal designates the one or more video signals of the second selection of digitized video signals to be transmitted by the second other apparatus,” as recited in claim 8, this feature simply cannot be inferred from Osakabe. Osakabe merely discloses that a TV set 10 sends a signal to a video recorder 20, in order to cause the video recorder to rerecord video data. However, nothing in Osakabe suggests that the video recorder generates this control signal. In any case, one skilled in the art would not be motivated to combine the teachings of Osakabe with the teachings of Lang, since Lang provides no external control possibility of the video recorder via an external bus, as is required according to the approach of Osakabe using bus 1.

For at least the foregoing reasons, dependent claims 8 and 9 are not rendered obvious by the combination of Lang and Osakabe.

V. Rejection of Claims 12-16 under 35 U.S.C. § 103(a)

Claims 12-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 6,330,025 (“Arazi”).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine

reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Applicants note that claim 12 recites substantially similar features as those recited in amended claim 1. As discussed in connection with claim 1, Lang fails to teach or suggest that the DVRC stipulates the video signals of the second selection, i.e., “facilitate designation of the digitized video signals of the second selection.” In addition, Lang does not teach or suggest that the DVRC has a network port. Furthermore, the teachings of Arazi simply do not remedy the deficiencies of Lang as applied against claim 12. Accordingly, any combination of Lang and Arazi would fail to approximate the invention of claim 12.

Independent of the above, Applicants note that one of ordinary skill in the art would not be motivated to combine the teachings of Arazi with the teachings of Lang, since Lang relates to a classical video recorder which is only intended for the simultaneous processing of a single data source, and Lang does not teach or suggest anything regarding the processing of several data sources (video cameras) simultaneously. Therefore, one skilled in the art would have no reason to provide a plurality of video cameras in Lang. In addition, one skilled in the art would derive no suggestion from Arazi to connect both the DVRC and the DVR to a plurality of video cameras.

For at least the foregoing reasons, claim 12 and its dependent claims 13-16 are not rendered obvious by the combination of Lang and Arazi.

VI. Rejection of Claim 19 under 35 U.S.C. § 103(a)

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 6,330,025 (“Arazi”).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

First of all, claim 19 depends on claim 17. Furthermore, the teachings of Arazi simply do not remedy the deficiencies of Lang as applied against parent claim 17. For at least these reasons, claim 19 is not rendered obvious by the combination of Lang and Arazi.

VII. Rejection of Claim 20 under 35 U.S.C. § 103(a)

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of Arazi, and further in view of Osakabe.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 20 depends on claim 19, which in turn depends on claim 17. Furthermore, the teachings of Osakabe simply do not remedy the deficiencies of Lang and Arazi as applied against parent claims 17 and 19. Accordingly, even if one assumes for the sake of argument that there were some motivation to combine the teachings of the applied references in the manner asserted by the Examiner (with which conclusion Applicants do not agree), the asserted combination would fail to approximate the claimed invention of dependent claim 20. For at least these reasons, the combination of Lang, Arazi and Osakabe does not render obvious dependent claim 20.

CONCLUSION

In view of all of the above, it is respectfully submitted that all of the presently pending claims 1-20 are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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